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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 10/618,166 | 07/10/2003 | Randall Eric Swanson | 2295-004 | 4355 |
| 20575 | 7590 | 10/17/2005 | | |
| MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204 | | | EXAMINER ZIRKER, DANIEL R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1771 | |

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/618,166 | Applicant(s) SWANSON, RANDALL ERIC | |
| | Examiner Daniel Zirker | Art Unit 1771 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 18-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 5, 20-23 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, claim 5 (and 20) is confusing in that "single sheet" appears to be defined in terms of itself and it is also not clear why a "single sheet" is a film that has multiple plies. Claim 21 still fails to have any connection to the remainder of the patch structure; i.e. is this a kit claim? Claims 22 and 23 lack any antecedent basis for the "center reinforcement" in claim 1. Finally, claims 24 and 27 are de facto duplicates.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-5 and 18-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More particularly, applicant has amended all of his claims so as to claim a wall patch comprising a single sheet....., and it is not clear to the Examiner where express or inherent support can be found in the specification for such a structure, since applicant has nowhere pointed out where

Art Unit: 1771

such support defining a "single sheet" exists and it is not readily apparent to the Examiner, i.e. it appears to be new matter. More particularly, the only language used in the specification to define such a structure is either couched in the vague and indefinite term "body" or recites at page 4, lines 20-22 of the specification that the most preferred "material for the body" is a particular 3-ply polypropylene film, and the Examiner further notes that the amended claims are now defined in terms of "comprising.....a single sheet" which however applicant desires to be a structure that can read on multi-ply films. Additionally, it also appears that one surface of the single sheet must be a ready to paint surface and that adhesive can be "on" the opposing opposite surface which from a description of the preferred embodiment clearly does not appear to be restricted to the same ply. Clarification is requested.

5. Claims 1,4 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Owens et al, substantially for the reasons set forth in Paragraph No. 10 of Paper No. 033105, together with the following additional observations. Applicant argues (Response, page 5, paragraphs 6 and 7) that they claim a "wall patch... comprised of a single sheet of material" and that the reference only discloses using three separate sheets of material to form the patch. However, the Examiner must respectfully note that at Col 3, lines 11-13 the reference discloses a "tough plastic sheet" that can be made from polypropylene, and that it can be coated "on" one surface with an adhesive and the "ready to paint upper surface" is believed either disclosed or clearly rendered obvious by the disclosure at Col 4, lines 19-24. Note also that in the Examiner's opinion the surface to be painted on, as well as

Art Unit: 1771

the opposing surface to be coated with adhesive does not have to be the "single sheet" in view of the chosen claim language and the openendedness of applicant's claim.

Note also that if the above statement is not correct the Examiner believes that it is also within the skill of the artisan to do the adhesive coating and painting directly on each of the two surfaces.

6. Claims 1,4 and 18 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoffman, Sr. '949, substantially for the reasons set forth in Paragraph No. 12 of Paper No 033105, together with the following additional observations. More particularly, with respect to applicant's sole argument that the wall patch of Hoffman is not ready to paint initially the Examiner can only note that at some point before painting the patch after being pretreated is ready to so be painted, and it is at this moment that the patch anticipates the claimed invention, which requires only an upper surface that is ready to be painted. Additionally, even if this were not to be true the Examiner also believes that such a limitation is within the ordinary skill of the art..

7. Claims 2,3,5,and 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Owens et al or Hoffman, Sr. '949, each taken individually, or alternatively as evidence of the state of the art in view of Swallow for claims 2,3, and 19, for claims 5 and 20 in view of the FASSON trade publication, and for claims 21-23 in view of Estrada, substantially for the reasons set forth in Paragraph No. 13 of Paper No. 033105, together with the following additional observations. Applicant has essentially not attacked the Examiner's reasoning except to attack each of the primary references

Art Unit: 1771

as seen above, which the Examiner again respectfully traverses for reasons previously set forth. With respect to the newly added dependent claims 24-28 which essentially read upon texturing the patch with a mixture of paint and mud it is respectfully submitted that such a structure is also well within the ordinary skill of the art, in the absence of unexpected results.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays

Art Unit: 1771

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Zirker
Primary Examiner
Art Unit 1771

A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive, flowing style.